

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Singh et al.)
Serial No.: 09/652,485)
Filed: 8/31/00)
For: Heterogenite Material for Making)
Submicron Cobalt Metal Powders)

Art Unit: 1742
Examiner: G. Wyszomierski

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Commissioner of Patents and Trademarks
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Sir:

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231, on

August 8, 2002
Robert F. Clark
Robert F. Clark Reg. No. 33,853

APPEAL BRIEF UNDER 37 C.F.R. 1.192

Applicants hereby present to the Board of Appeals their Brief in support of their Appeal from the decision of the Primary Examiner finally rejecting claims 1 and 2 in the above-identified application.

Please charge the required fee of \$320.00 to Deposit Account No. 15-0689. This page is submitted in triplicate for fee purposes.

Three copies of the Brief are enclosed.

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REAL PARTY IN INTEREST

OSRAM SYLVANIA Inc., 100 Endicott Street, Danvers, Massachusetts is the Real Party in Interest as the owner of the entire interest in the above-identified application.

RELATED APPEALS AND INTERFERENCES

As of the filing of this Brief, there are no related appeals or interferences known to the appellants, the appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF THE CLAIMS

Claims 1 and 2 stand rejected. Claims 1 and 2 are appealed. They are delineated in the Appendix attached hereto.

STATUS OF AMENDMENTS

All Amendments have been entered.

SUMMARY OF THE INVENTION

The claimed invention is a high-surface-area heterogenite (HCoO_2) material which can be used in the making of submicron cobalt metal powders. The HCoO_2 material has a surface area of at least about $90 \text{ m}^2/\text{g}$ and is preferably produced by dehydrating a cobalt hydroxide precipitate at 110°C . *Specification* at 3, lines 1-13

ISSUES

Whether claims 1 and 2 are unpatentable under 35 U.S.C §102(a) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Yamada et al.

Whether claims 1 and 2 are unpatentable under 35 U.S.C §102(a) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the Abstract of JP 10-188970.

GROUPING OF CLAIMS

Claims 1 and 2 are considered to stand together.

ARGUMENTS

The rejection of claims 1 and 2 under 35 U.S.C §102(a) or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Yamada et al. is believed to be in error and reversal is respectfully requested.

The Examiner acknowledges that Yamada et al. does not disclose a heterogenite material having a surface area as claimed by the Applicants. *First Office Action* (8/29/01) However, the Examiner attempts to make up for this lack of disclosure by asserting that since Yamada et al. teaches making a heterogenite material by heating to the same or similar temperature as used by the Applicants the heterogentite material of Yamada et al. inherently possesses the claimed surface area. As proof the Examiner points to Yamada, col. 3, l. 59. *Final Office Action* (3/25/02). And finally, as a catchall, the Examiner asserts that "[a]t the very least, the examiner's position is that one of ordinary skill in the art would be aware of the relationship between surface area and such parameters as particle size, density, and packing factors ... [and] would have been able to control the particle size of the heretogenite material obtained in the prior art through control of one or more of these parameters." This leads the Examiner to the conclusion that "the making of a heterogenite materials of a given surface area, such as the surface area recited in the instant claims, would have been well within the level of one of ordinary skill in the art given the disclosures of Yamada et al." *Final Office Action* at 3.

The Applicants respectfully assert that the Examiner is in error. Yamada et al. does not form a heterogenite material by heating; *Yamada applies a heat-treatment to a heterogenite material*. Yamada states that "cobalt compounds [substantially represented by the formula HCoO_2] can stably be used as the cobalt compound of the present invention either directly or after a heat-treatment." Col. 3, ll. 53-57 (emphasis added). The heterogentite material of Yamada is a starting material and not an end product. Yamada does not teach how the heterogentite starting material is obtained nor does Yamada teach how to manipulate any of the parameters cited by Examiner to achieve a high-surface-area heterogenite material. Furthermore, it is well established that common knowledge and common sense do not substitute for authority when the law requires authority. *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When an assertion of general knowledge is made to negate patentability, that knowledge must be articulated and placed of the record. *Id.* at 1435. The law requires more than just the Examiner's conclusory statements. The Applicants respectfully assert that the Examiner has not articulated how general knowledge of the above-mentioned relationships makes obvious the Applicants'

claimed invention. Therefore, the Applicants respectfully assert that Applicants' claimed heterogenite powder is not anticipated by or obvious in view of Yamada et al.

The rejection of claims 1 and 2 under 35 U.S.C §102(a) or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over the Abstract of JP 10-188970. is believed to be in error and reversal is respectfully requested.

As in the above rejection, the Examiner acknowledges that the Abstract of JP 10-188970 does not disclose the surface area of the heterogenite material. Instead, the Examiner again states that, since the prior art materials appear to be of the same composition and produced in essentially the same manner, the prior art material is substantially identical as the claimed material. As with Yamada et al., the Examiner alleges that the Abstract forms the heterogenite material by heating to the same or similar temperature used by the Applicants as support for this rejection. The Examiner also resorts to the same catchall that that one of ordinary skill in the art would be aware of the relationship between surface area and such parameters as particle size, density, and packing factors and therefore would have been able to control the particle size of the heretogenite material obtained in the prior art through control of one or more of these parameters

The Applicants respectfully assert that the Examiner is incorrect. The heterogenite material in the Abstract of JP 10-188970 is described as being formed as a layer on a nickel hydroxide particle and then heated. The Abstract does not teach forming the heterogenite layer by heating. Therefore, the Abstract does not produce the heterogenite material in the same manner as the Applicants. The Applicants further reiterate their objection to the use of the catchall as stated in the above rejection with respect to Yamada et al. There is no teaching in the Abstract of how to manipulate any of the parameters cited by Examiner to achieve a high-surface-area heterogenite material. Thus, the Applicants respectfully assert that the claimed invention is not anticipated by or obvious in view of the Abstract of JP10-188970

As a final matter, the Applicants in their June 19, 2002 Response to the *Final Office Action* brought to the Examiner's attention the recent non-precedential decision of the Board in *Ex parte Jones*¹ in which the Board stated its reservations about the propensity of Examiners to rely on the abstracts of references and not on the underlying reference itself. It was the view of the Board that this practice is generally inappropriate when both the abstract and the underlying document are prior art. The Applicants further requested that the Examiner at least temporarily withdraw

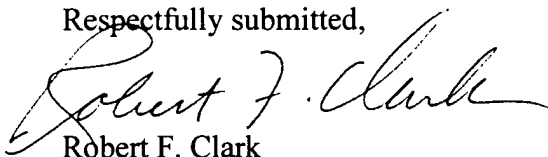
¹ *Ex parte Jones*, 62 USPQ2d 1207 (BPAI 11/28/01).

the rejection and provide a translation of the underlying document in order to better prepare the application for appeal should one be necessary. The Examiner responded in the Advisory Action mailed 7/16/02 that further consideration would be given to having a complete translation made if the Applicants should continue to pursue an appeal. The Applicants respectfully assert that this response fails to fulfill the policy set forth in *Ex Parte Jones* and would violate 37 C.F.R. §1.193(a)(2) which prohibits the Examiner from including a new ground of rejection in the Examiner's answer to an appeal brief.² Thus, the Applicants request that the Board remove the finality of the Examiner's rejection and send the application back to the Examiner for continued prosecution based on the translation of the full document.

CONCLUSION

Accordingly, it is submitted that error was made in the rejection of the claims under 35 U.S.C. §§102 and 103, and reversal is respectfully requested.

Respectfully submitted,



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² The translated document would be a new reference and therefore constitute a new ground of rejection.

APPENDIX

1. A heterogenite powder having a surface area at of least about $90 \text{ m}^2/\text{g}$.
2. The heterogenite powder of claim 1 wherein the surface area is from about $90 \text{ m}^2/\text{g}$ to about $110 \text{ m}^2/\text{g}$.

Chemtall's (or Morton's) knowledge and approval markedly differs from allegations of misuse or misappropriation of secret information. Consequently, the former allegation is not displaced by the ITSA. Count IV of the plaintiff's Complaint stands.

III. Punitive Damages Claim

[2] The defendants argue that plaintiff's claim for punitive damages is based upon "some fiduciary duty owed to Plaintiff by virtue of the Fraval's various employment-related contracts with Morton," and therefore untenable. (Def.'s Min. to Dismiss, pg. 13). This court finds, however, that the punitive damage claim is allowable by statute, 765 ILCS 1065/4(b). Consequently, the count VI as alleged stands.

Conclusion

For the foregoing, the defendants' motion to dismiss counts II-V of the plaintiff's Complaint is DENIED.

Ex parte Jones

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences
Appeal No. 2001-1839
Decided November 28, 2001

(Non-precedential)

PATENTS

[1] Patentability/Validity — Obviousness — Combining references (§ 115.0905)

"Motivation" to combine teachings of prior art is not always required to support obviousness rejection under 35 U.S.C. § 103, since legally sufficient rationale for finding of obviousness may be supported by reason or suggestion in prior art, as well as motivation, to combine teachings.

[2] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Rules and rules practice (§ 110.1105)

Patentability/Validity — Obviousness — Relevant prior art — In general (§ 115.0903.01)

Patent examiner's citation of abstract in support of rejection without citation and reli-

ance on underlying scientific article is generally inappropriate if both abstract and underlying document are prior art, and proper examination therefore should be based on underlying documents and translations, if necessary, since abstracts often are not written by author of underlying document, and may be erroneous; in present case, in which neither examiner nor applicant relies on underlying articles, Board of Patent Appeals and Interferences, in exercise of its discretion, will not obtain translations of underlying journal articles in order to evaluate merits of translations in first instance, since it is examiner's responsibility to obtain translations, and since review of translations by examiner and applicant may supply additional evidence as to whether there is legally sufficient reason, suggestion, teaching, or motivation to combine teachings of cited articles, and thus may eliminate need for appeal.

Patent application of Jones, serial no. 08/947,428.¹ Applicant appeals from examiner's rejection of claims 38 and 39 in application. Vacated and remanded.

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the Board.] Before Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

McKelvey, S.J.

Decision on appeal under 35 U.S.C. § 134

The appeal is from a decision of a primary examiner rejecting claims 38-39. We vacate and remand for action not inconsistent with views expressed herein.

A. Findings of fact

The record supports the following findings by at least a preponderance of the evidence:

1. The claimed invention relates to a method of making organic chemicals.
2. The examiner has rejected claims 38-39 as being unpatentable under 35 U.S.C. § 103(a) over

¹ Application for patent filed 8 October 1997.

² To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

- a) Homer,
- b) Suri,
- c) Endel' man,
- d) Manthey and
- e) Oia.

3. Homer is a 25-page technical journal article written in German.

4. The examiner has placed in the record a short English-language abstract of Homer.

5. The record does not contain an English-language translation of Homer.

6. Suri is a 2-page technical journal article written in English.

7. Endel' man is a 4-page technical journal article written in Russian.

8. The examiner has placed in the record a short English-language abstract of Endel' man.

9. The record does not contain an English-language translation of Endel' man.

10. Manthey is a 5-page technical journal article written in English.

11. Oia appears to be a 5-page technical journal article written in Japanese.

12. The examiner has placed in the record a short English-language abstract of Oia.

13. The record does not contain an English-language translation of Oia.

14. The examiner does not maintain that any one of the five prior art references fully describes the claimed invention. Hence, a rejection based on 35 U.S.C. § 103(a).

15. According to the examiner, "the skilled artisan looking for an alternative route for the preparation" of the product produced by the claimed method "was deemed to be aware of all the various methods of the preparation" of the product (Examiner's Answer, page 4).

16. Further according to the examiner, "one of ordinary skill in the art would be motivated [sic—would have been motivated] to prepare *** [the compound made by applicant's claimed method] by coupling Suri's *** acid and Endel' man's *** acid as taught by Manthey followed by *** [further treatment] to yield *** [a compound] as taught by Homer and subsequent reduction as taught by Oia to arrive at the *** [claimed process]" (Examiner's Answer, pages 4-5).

17. According to applicant, the requisite "motivation" is not present in the prior art because "[t]hroughout the prosecution the examiner has failed to point out any teaching or suggestion in the prior art that would motivate the skilled artisan" to use the claimed process invention (Appeal Brief, page 4).

B. Discussion

1. Rationale in support of obviousness

[1] The applicant and the examiner have apparently assumed that there always must be "motivation" to combine teachings of the prior art to support a rejection based on § 103(a). The assumption is not correct. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a *prima facie* obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flat-head screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flat-head screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not "motivate" use of Phillips head screws in place of flathead screws.

What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a § 103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant); *In re Garrside*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000) (the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a teaching or motivation to combine prior art references); *Pro-Mold and Tool Co. v. Great*

Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996) ("there must be a reason, suggestion, or motivation *** to combine [the teachings of] *** references ***"); *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references).

2. Use of abstracts in place of underlying articles

The principal difficulty with the prosecution of the application on appeal is the examiner's attempt to establish "motivation" by reliance on three English-language abstracts of journal articles written in foreign languages. The examiner does not maintain that only Suri and Manthey, both in English, support the rejection. The use of abstracts, when the underlying document is prior art, gives us considerable pause.

The Board of Patent Appeals and Interferences continues to have recurring problems in resolving *ex parte* appeals which come before it. One continuing recurring problem is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document.

[2] In this appeal, the examiner relied upon abstracts of three technical journal articles without referring to translations of the underlying documents. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. Abstracts often are not written by the author of the underlying document and may be erroneous. It is our opinion that a proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.

When an examiner cites and relies only on an abstract, the applicant may wish to obtain a copy of the underlying document and submit a copy to the examiner when responding to a rejection relying on an abstract. In the event a reference is in a foreign language, if the applicant does not wish to expend resources to obtain a translation, the applicant may wish to request the examiner to supply a translation. If

a translation is not supplied by the examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 CFR § 1.181) to have the examiner directed to obtain and supply a translation.

In the past, when neither the examiner nor the applicant relies on the underlying article, the board often expended the resources necessary to obtain a copy of the underlying scientific article, as well as translations thereof. When it did so, however, the burden of examining the application fell on the board in the first instance. Moreover, to the extent that the board relies on parts of a translation not previously provided to an applicant, any affirmance generally has to be a new ground of rejection under 37 CFR § 1.196(b)—which can result in further prosecution.

In this case, we do not know whether the examiner or the applicant had or reviewed the underlying foreign language technical journal articles or translations thereof. The board cannot examine, in the first instance, all applications which come before it in an *ex parte* appeal under 35 U.S.C. § 134. In this particular appeal, we exercise discretion by declining to obtain translations of the underlying technical journal articles and thereafter evaluate on the merits in the first instance the translations. In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings of the five technical journal articles. Moreover, an evaluation of translations may eliminate the need for an appeal.

C. Decision

The decision of the examiner rejecting claims 38-39 under 35 U.S.C. § 103(a) over (1) Homer, (2) Suri, (3) Endel' man, (4) Manthey and (5) Ota is *vacated* and the application is *remanded* to the examiner. For the effect of a decision vacating an examiner's rejection, see *In re Zambrano*, 58 USPQ2d 1312 (Bd. Pat. App. & Int. 2001) (explaining that vacated rejection no longer exists).

The examiner and/or the applicant may obtain translations of (A) Homer, (B) Endel' man and (C) Ota.

Nothing in this opinion should be read as precluding the examiner from entering a rejection.

tion based on translations. In the event the examiner determines that claims 38-39 are unpatentable over the combination of the five references (or any additional prior art), then the examiner must identify and cite the specific portions (page and line or figure) of each article or prior art document upon which he relies in support of any rejection. We are primarily a board of review. Accordingly, neither the examiner nor applicant should expect in any further appeal for us to dig through five prior art references to come up with a theory which might support or negate a rejection in the first instance. Moreover, if the examiner enters a further rejection based on foreign language document, translations must be obtained if a further appeal is taken. We will not decide a further appeal without translations.

We express no views on the ultimate merits of any rejection under 35 U.S.C. § 103(a) based on the five prior art references or any additional prior art which the examiner and applicant may wish to make of record.

D. Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the examiner's rejection under § 103(a) of claims 38-39 is *vacated*.
FURTHER ORDERED that the application is *remanded* to the examiner for action not inconsistent with the views expressed in this opinion.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

VACATED and REMANDED

Ex parte Gambogi

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences
Appeal No. 2001-1022

Decided December 10, 2001

(Non-precedential)

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Rules

signs was not legally erroneous, and because we find that the Board's finding that Valu's guide rails are *de jure* functional is supported by substantial evidence, the Board's refusal to register Valu's guide rail designs is *affirmed*, and Rexnord's cross-appeal is dismissed as moot.

AFFIRMED

COSTS

No costs.

e Lee

U.S. Court of Appeals
Federal Circuit

No. 00-1158

Decided January 18, 2002

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — In general (§ 110.1101)

Patentability/Validity — Obviousness — Combining references (§ 115.0905)

Patentability/Validity — Obviousness — Evidence of (§ 115.0906)

Rejection of patent application for obviousness under 35 U.S.C. § 103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record, and Board of Patent Appeals and Interferences must explain reasons why one of ordinary skill in art would have been motivated to select references and to combine them to render claimed invention obvious.

[2] Patentability/Validity — Obviousness — Combining references (§ 115.0905)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

Board of Patent Appeals and Interferences improperly relied upon "common knowledge and common sense" of person of ordinary skill in art to find invention of patent application obvious over combination of two prior art references, since factual question of motivation to select and combine references is material to patentability, and could not be resolved on subjective belief and unknown authority, since deferential review of agency decisions under Administrative Procedure Act reinforces obligation of board to develop evidentiary basis for its findings, since board's rejection of need for any specific hint or suggestion in particular reference to support combination constituted omission of relevant factor required by precedent, and thus was both legal error and arbitrary agency action, since board's findings must extend to all material facts and be documented on record, and since "common knowledge and common sense" are not specialized knowledge and expertise of agency contemplated by APA, and may not be substituted for evidence, although they may be applied to analysis of evidence.

PATENTS

[3] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — In general (§ 110.1101)

Patentability/Validity — Obviousness — Evidence of (§ 115.0906)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

Patent examiners and Board of Patent Appeals and Interferences, in relying on what they assert to be general knowledge to negate patentability on ground of obviousness, must articulate that knowledge and place it on record, since examiners and board are pre-

sumed to act from viewpoint of person of ordinary skill in art in finding relevant facts, assessing significance of prior art, and making ultimate determination of obviousness issue; failure to do so is not consistent with either effective administrative procedure or effective judicial review, and board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth rationale on which it relies.

[4] Procedure — Court of Appeals for the Federal Circuit (§ 410.03)

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

U.S. Court of Appeals for the Federal Circuit will not consider proposed alternative grounds for affirming decision of Board of Patent Appeals and Interferences rejecting patent application for obviousness, since alternative grounds were made at oral argument and constitute post hoc rationalization for agency action, consideration of which would deprive aggrieved party of fair opportunity to support its position.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Sang-Su Lee, serial no. 07/631,210, directed to method of automatically displaying functions of video display device and demonstrating how to select and adjust functions to facilitate user response. Applicant appeals from decision upholding rejection of all claims for obviousness, and from reaffirmation of that decision on reconsideration. Reversed and remanded.

Richard H. Stern and Robert E. Bushnell, Washington, D.C., for Sang Su Lee.
Sidney O. Johnson Jr., associate solicitor, John M. Whealan, solicitor, and Raymond T. Chen, Maximilian R. Peterson, and Mark Nagumo, associate solicitors, Arlington, Va., for Director of U.S. Patent and Trademark Office.

Before Newman, Clevenger, and Dyk, circuit judges.

Newman, J.

Sang-Su Lee appeals the decision of the Board of Patent Appeals and Interferences of

the United States Patent and Trademark Office, rejecting all of the claims of Lee's patent application Serial No. 07/631,210 entitled "Self-Diagnosis and Sequential-Display Method of Every Function."¹ We vacate the Board's decision for failure to meet the adjudicative standards for review under the Administrative Procedure Act, and remand for further proceedings.

The Prosecution Record

Mr. Lee's patent application is directed to a method of automatically displaying the functions of a video display device and demonstrating how to select and adjust the functions in order to facilitate response by the user. The display and demonstration are achieved using computer-managed electronics, including pulse-width modulation and auto-fine-tuning pulses, in accordance with procedures described in the specification. Claim 10 is representative:

10. A method for automatically displaying functions of a video display device, comprising:

determining if a demonstration mode is selected;

if said demonstration mode is selected, automatically entering a picture adjustment mode having a picture menu screen displaying a list of a plurality of picture functions; and

automatically demonstrating selection and adjustment of individual ones of said plurality of picture functions.

The examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the Nortrup display does not include a demonstration of how to adjust the functions. The Thunderchopper Handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game; however, the Thunderchopper Handbook makes no mention of the adjustment of picture or audio functions. The examiner held that it

¹ *Ex parte Lee*, No. 1994-1989 (Bd. Pat. App. & Int. Aug. 30, 1994; on reconsideration Sept. 29, 1999).

would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system.

Lee appealed to the Board, arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated:

The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Board op. at 7. The Board did not explain the "common knowledge and common sense" on which it relied for its conclusion that "the combined teachings of Nortrup and Thunderchopper would have suggested the claimed invention to those of ordinary skill in the art."

Lee filed a request for reconsideration, to which the Board responded after five years. The Board reaffirmed its decision, stating that the Thunderchopper Handbook was "analogous art" because it was "from the same field of endeavor" as the Lee invention, and that the field of video games was "reasonably pertinent" to the problem of adjusting display functions because the Thunderchopper Handbook showed video demonstrations of the "features" of the game. On the matter of motivation to combine the Nortrup and Thunderchopper references, the Board stated that "we maintain the position that we stated in our earlier decision" and that the Examiner's Answer provided "a well reasoned discussion of why there is sufficient motivation to combine the references." The Board did not state the examiner's reasoning, and review of the Examiner's Answer reveals that the examiner merely stated that both the Nortrup function menu and the Thunderchopper demonstration mode are program features and that the Thunderchopper mode "is user-friendly" and it functions as a tutorial, and that it would have been obvious to combine them.

Lee had pressed the examiner during prosecution for some teaching, suggestion, or motivation in the prior art to select and combine

the references that were relied on to show obviousness. The Examiner's Answer before the Board, plus a Supplemental Answer, stated that the combination of Thunderchopper with Nortrup "would have been obvious to one of ordinary skill in the art since the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software," and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial." The Board adopted the examiner's answer, stating "the examiner has provided a well reasoned discussion of these references and how the combination of these references meets the claim limitations." However, perhaps recognizing that the examiner had provided insufficient justification to support combining the Nortrup and Thunderchopper references, the Board held, as stated *supra*, that a "specific hint or suggestion" of motivation to combine was not required.

This appeal followed.

Judicial Review

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

5 U.S.C. § 706(2) The reviewing court shall—

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal

must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts. The Court has often explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decisionmaking." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 374 (1998) (citation omitted). This standard requires that the agency not only have reached a sound decision, but have articulated the reasons for that decision. The reviewing court is thus enabled to perform meaningful review within the strictures of the APA, for the court will have a basis on which to determine "whether the decision was based on the relevant factors and whether there has been a clear error of judgment." *Citizens to Preserve Overton Park v. Volpe*, 401 U.S. 402, 416 (1971). Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (review is on the administrative record); *In re Garbide*, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000) (Board decision "must be justified within the four corners of the record").

[1] As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a

teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffert*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combina-

tion. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

[2] With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Norrup and Thunderchopper references to the order obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Deferral judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., *Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting *Burlington Truck Lines v. United*

States, 371 U.S. 156, 168 (1962)); *Securities & Exchange Comm'n v. Chenery Corp.*, 318 U.S. 80, 94 (1943) ("The orderly function of the process of review requires that the grounds upon which the administrative agency acted are clearly disclosed and adequately sustained.").

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Norrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See *Motor Vehicle Manufacturers*, 463 U.S. at 43 ("an agency rule would be arbitrary and capricious if the agency . . . entirely failed to consider an important aspect of the problem"); *Mullins v. Department of Energy*, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action."). As discussed in *National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp.*, 817 F.2d 74, 75 (9th Cir. 1987), an agency is "not free to refuse to follow circuit precedent."

The foundation of the principle of judicial deference to the rulings of agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency's application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See *Baltimore and Ohio R. Co. v. Aberdeen & Rockfish R. R. Co.*, 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would become lost "in the haze of so-called expertise"). The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by

relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Alternative Grounds

[4] At oral argument the PTO Solicitor proposed alternative grounds on which this court might affirm the Board's decision. However, as stated in *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 168 (1962), "courts may not accept appellate counsel's post hoc rationalization for agency action." Consideration by the appellate tribunal of new agency justifications deprives the aggrieved party of a fair opportunity to support its position; thus review of an administrative decision must be made on the grounds relied on by the agency. "If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis." *Securities & Exchange Comm'n v. Chenery Corp.*, 332 U.S. 194, 196 (1947). As reiterated in *Federal Election Comm'n v. Akins*, 524 U.S. 11, 25 (1998), "If a reviewing court agrees that the agency misinterpreted the law, it will set aside the agency's action and remand the case — even though the agency (like a new jury after a mistrial) might later, in the exercise of its lawful discretion, reach the same result for a different reason." Thus we decline to consider alternative grounds that might support the Board's decision.

Further Proceedings

Sound administrative procedure requires that the agency apply the law in accordance with statute and precedent. The agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action. In *Radio-Television News Directors Ass'n v. FCC*, 184 F.3d 872 (D.C.

the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See *Allenstown Mack*, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . .").

The case on which the Board relies for its departure from precedent, *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that *Bozek*'s reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

[3] The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the

Cir. 1999) the court discussed the "fine line between agency reasoning that is 'so crippled as to be unlawful' and action that is potentially lawful but insufficiently or inappropriately explained," quoting from *Checkosky v. Securities & Exch. Comm'n*, 23 F.3d 452, 464 (D.C. Cir. 1994); the court explained that "[i]n the former circumstance, the court's practice is to vacate the agency's order, while in the latter the court frequently remands for further explanation (including discussion of the relevant factors and precedents) while withholding judgment on the lawfulness of the agency's proposed action." *Id.* at 888. In this case the Board's analysis of the Lee invention does not comport with either the legal requirements for determination of obviousness or the requirements of the Administrative Procedure Act that the agency tribunal set forth the findings and explanations needed for "reasoned decisionmaking." Remand for these purposes is required. See *Overson Park*, 401 U.S. at 420-221 (remanding for further proceedings appropriate to the administrative process).

VACATED AND REMANDED

Barbour v. Head

U.S. District Court
Southern District of Texas
No. G-01-491

Decided December 21, 2001

COPYRIGHTS

III Non-copyrightable matter — Ideas and systems (§ 211.05)

Defendants are not entitled to summary judgment that plaintiffs' cooking recipes are uncopyrightable, even though 17 U.S.C. § 102(b) denies copyright protection to mere procedures or processes, since neither courts nor Register of Copyrights have declared that recipes are per se uncopyrightable, since defendants have not shown that plaintiffs' cookbook is copyrighted as factual compilation or collective work rather than literary work, and since even if book is not literary work, genuine issue of material fact exists as to whether plaintiffs' recipes, which contain more than mechanical listings of ingredients and cooking

instructions, represent mere unprotected facts or protectable expression.

JUDICIAL PRACTICE AND PROCEDURE

[2] Procedure — Limitations period; timeliness (§ 410.05)

Plaintiffs' claim for copyright infringement is not barred by three-year statute of limitations specified by 17 U.S.C. § 507(b), even though infringement claim was brought more than three years after infringing work was first published, since discovery rule and other equitable tolling doctrines apply to copyright claims, since plaintiffs' cause of action arguably did not accrue until they discovered defendants' book, less than one year before suit was brought, and since even if claim accrued on date of first publication, limitations period bars only remedy, not substantive right.

Action by Judy Barbour and Cookbook Resources LLC against James Head and Penfield Press Inc. for copyright infringement, and for unfair competition through misappropriation and conversion. On defendants' motion for summary judgment. Denied as to copyright claims; granted as to state law claims.

G.P. Hardy III, Houston, Texas, for plaintiffs.

Karen Bryant Tripp, Houston, for defendants.

Kent, J.

ORDER GRANTING IN PART DEFENDANT PENFIELD PRESS' MOTION TO DISMISS

This case involves a rustled cowboy cookbook. On August 13, 2001, Plaintiffs Judy Barbour ("Barbour") and Cookbook Resources, L.L.C. ("Cookbook Resources") filed causes of action for copyright infringement, unfair competition through misappropriation, and conversion, with which they're fixin' to brand Defendants James Head ("Head") and Penfield Press, Inc. ("Penfield Press"). On October 25, 2001, to bust out of the corral, Defendant Penfield Press filed a Motion to Dismiss pursuant to Fed.R.Civ.P. 12(b)(6). For the reasons articulated below, Defendant's Motion to Dismiss shall be

treated as a Motion for Summary Judgment and GRANTED IN PART.

I. FACTUAL SUMMARY

Plaintiff Barbour is the rootin'-tootin' author of *Cowboy Chow*,¹ a Texas-themed cookbook containin' larapin recipes, entertainin' ideas, histoical information, and other cowboy fun. According to Plaintiffs, Barbour obtained a registered copyright on *Cowboy Chow* when it was first published in 1988. Following the book's initial commercial success, there being a lot of hungry cowpokes out there, Barbour entered into a publishing and manufacturing agreement with Cookbook Resources on February 24, 2001, whereby Cookbook Resources acquired Barbour's copyright on *Cowboy Chow*. Sometime prior to or during 1996, an internet magazine published by Defendant Head, called *Texas Online*, began publishing virtually verbatim recipes from *Cowboy Chow* without Barbour's knowledge or consent. In 1996, Defendant Penfield Press published a compilation cookbook by author Dianna Stevens ("Stevens") entitled *License to Cook Texas Style*,² that similarly published virtually verbatim recipes from *Cowboy Chow* without Barbour's knowledge or permission. Many of these recipes were expressly credited to Jim Head at *Texas Online*.³ After discovering these copyright infringements in May of 2001, Barbour and Cookbook Resources filed this lawsuit, specifically bringing causes of

action for copyright infringement under the Copyright Act of 1976 ("Copyright Act"), 17 U.S.C. § 101 *et seq.*, and Texas state law claims for unfair competition through misappropriation and conversion.

In its Motion to Dismiss, Defendant Penfield Press seeks a dismissal of Plaintiffs' claims based on the following three grounds: (1) Plaintiffs' recipes are not copyrightable; (2) Plaintiffs' claims are barred by the applicable statutes of limitations; and (3) Plaintiffs' state law claims are preempted by federal law. Defendant also identifies approximately twenty recipes that it contends are identical, or similar, to those stated in *Cowboy Chow*.⁴ Each of these recipes shares the same or a similar title, listing of ingredients, and directions for preparation, as well as sometimes employing other miscellaneous identical language. Among the highlights from this templating list of "cow-mestibles" are "Armadillo Eggs," "Cattle Baron Cheese Dollars," "Gringo Gulch Grog," and the ever-chic "Frito Pie." In their Response, Plaintiffs refute Defendant's assertions that the alleged copied material is not copyrightable and that Plaintiffs' claims are time-barred, but concede that their state law claims properly sound in copyright and therefore are preempted by federal copyright law.

II. ANALYSIS

A. Proper Treatment of Defendant's Motion

Penfield Press characterizes its motion as a Motion to Dismiss for Failure to State a Claim Upon Which Relief Can be Granted pursuant to Fed.R.Civ.P. 12(b)(6). However, the Court finds that Defendant is actually seeking summary judgment relief under Fed.R.Civ.P. 56. In relevant part, Rule 12(b) stipulates: "If, on a motion asserting the defense numbered (6) to dismiss for failure of the pleading to state a claim upon which relief can be granted, matters outside the pleading are presented to and not excluded by the court, the motion shall be treated as one for summary judgment and disposed of as provided in Rule 56." Fed.R.Civ.P. 12(b). In the instant case, Defendant attached five exhibits to its Motion to Dismiss, including two affidavits, a copy of *License to Cook Texas Style*, and substantial portions of

⁴ In addition, no doubt, to being lip-smackin' good!

¹ It could have been named *How Now to Brown a Cow*....

² Which could have been called *And the Cow Jumped Over the Spoon*....

³ In her affidavit, Stevens declares that she found some recipes on the internet website, *Texas Online*, and then published them in *License to Cook Texas Style* with Head's express permission. Per Head's request, Stevens credited Jim Head and *Texas Online* for each recipe obtained from *Texas Online*. However, Stevens claims she never saw a copy of *Cowboy Chow* until the filing of this lawsuit. (Stevens Decl. ¶ 3, 5).

The Court has previously enunciated its belief that the Internet is "one large catalyst for rumor, innuendo, and misinformation," in large part because it provides no way of verifying the authenticity of the information it presents. *St. Clair v. Johnny's Oyster & Shrimp, Inc.*, 76 F. Supp.2d 773, 774 (S.D. Tex. 1999) (Kent, J.). The instant lawsuit aptly demonstrates that "[a]nyone can put anything on the Internet. No web-site is monitored for accuracy and nothing contained therein is under oath or even subject to independent verification absent underlying documentation." *Id.* at 775. In short, information obtained from the Internet is "inherently untrustworthy." *Id.* at 774.